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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/748,642	12/22/2000	Thomas B. Albrecht	026.00041	4973

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ROGALSKY & WEYAND, LLP  
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EXAMINER
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ASHEN, JON BENJAMIN

ART UNIT	PAPER NUMBER
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1635

DATE MAILED: 05/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action  
Before the Filing of an Appeal Brief**

Application No.

09/748,642

Applicant(s)

ALBRECHT ET AL.

Examiner

Jon B. Ashen

Art Unit

1635

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 25 April 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.  
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**NOTICE OF APPEAL**

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

**AMENDMENTS**

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☐ They raise the issue of new matter (see NOTE below);  
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
5. ☒ Applicant's reply has overcome the following rejection(s): See Continuation Sheet.  
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
The status of the claim(s) is (or will be) as follows:  
Claim(s) allowed: \_\_\_\_\_.  
Claim(s) objected to: \_\_\_\_\_.  
Claim(s) rejected: 6, 7, 14 and 15.  
Claim(s) withdrawn from consideration: \_\_\_\_\_.

**AFFIDAVIT OR OTHER EVIDENCE**

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

**REQUEST FOR RECONSIDERATION/OTHER**

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
See Continuation Sheet.  
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). \_\_\_\_\_.  
13. ☐ Other: \_\_\_\_\_.

Continuation of 5. Applicant's reply has overcome the following rejection(s): 35 U.S.C. § 102(e) rejection of claims 86-7, 14 and 15 under Potter et al. .

Continuation of 11. does NOT place the application in condition for allowance because: Claims 6-8 and 14-16 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Roizman et al. (Reference 1 on PTO form 1449, filed July 19, 2002), Henkart et al. (reference 2 on PTO form 1449, filed July 19, 2002), Kido et al. (Reference 1 on PTO form 1449, filed December 16, 2004) and deJong et al. 1998 (Antiviral Research, Vol. 39: pp. 141-162) for the reasons of record as set forth in the Action mailed 05/04/2005. Applicant's arguments, filed 4/25/2006 with regard to the outstanding rejection of claims 6-7, 14 and 15 under 35 U.S.C. 103(a) as being unpatentable over Roizman et al. (Reference 1 on PTO form 1449, filed July 19, 2002), Henkart et al. (reference 2 on PTO form 1449, filed July 19, 2002), Kido et al. (Reference 1 on PTO form 1449, filed December 16, 2004) and deJong et al. 1998 (Antiviral Research, Vol. 39: pp. 141-162) have been fully considered but are not persuasive for the reasons of record as set forth in the Actions mailed 05/04/2005 and 1/27/2006. Applicant's arguments (pgs. 3-6) are substantively the same as those of record and were addressed and found to be non-persuasive in the action mailed 1/27/2006 (section 6, pgs. 6-9.). Applicant's has argued (pg. 6), that "Contrary to the assertion of the outstanding office action, applicants are not arguing the references individually as if the rejection was under 35 U.S.C. § 102. Applicants are instead pointing out that none of the references teach or suggest using the specified calpain inhibitors to treat HCMV, therefore, the combination of references likewise does not teach or suggest the present invention. It is clear, however, from the statement above, that Applicants are arguing that because none of the individual references teach or suggest using the specified calpain inhibitors to treat HCMV that "the combination of references likewise does not teach or suggest the present invention." However, as set forth in the reasons of record, the outstanding rejection is under 35 U.S.C. § 103(a), one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See In re Keller, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); In re Merck & Co., 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986)..

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PRIMARY EXAMINER